REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 1-33 are pending; Claims 28 and 31 are amended; and no claims are newly added or canceled herewith. It is respectfully submitted that no new matter is added by this amendment, as this amendment merely addresses typographical errors.

In the outstanding Office Action, Claims 1, 12, 23, 31, and 32 were rejected under 35 U.S.C. § 103(a) as unpatentable over Oberlander et al. (U.S. Pat. No. 5,825,865, hereafter "the '865 patent") in view of Ronen et al. (U.S. Pat. No. 5,905,736, hereafter "the '736 patent"); and Claims 2-11, 13-22 and 24-30 were rejected under 35 U.S.C. § 103(a) as unpatentable over the '865 patent in view of the '736 patent and further in view of Blonder et al. (U.S. Pat. No. 5,708,422, hereafter "the '422 patent"). Claim 33 was allowed.

Applicants acknowledge with appreciation the indication that Claim 33 is allowed. Because this claim has not been amended herewith, it is respectfully submitted that Claim 33 remains in condition for allowance.

With respect to the outstanding rejection of Claims 1, 12, 23, 31, and 32 under 35 U.S.C. § 103(a) as unpatentable over the '865 patent in view of the '736 patent, that rejection is respectfully traversed.

It is respectfully submitted that the Office Action has not established a *prima facie* case of obviousness with respect to Claims 1, 12, 23, 31, and 32. Independent Claim 1 recites, in part, "the telephony processes having a dynamically assigned protocol address that is dynamically assigned upon connecting to an Internet and is temporary for each instance of connecting to the Internet," which the Office Action has again failed to establish is taught or suggested by the cited references. The remaining independent claims recite analogous features.

The outstanding rejection relies upon the '865 patent, which the Office Action admits "fails to disclose the features of having call package generated from telephony processes, which have dynamically assigned Internet protocol addresses, and having a central server for storing the dynamically assigned protocol addresses to establish an Internet telephony communication between the telephony processes as claimed."[1] Despite this admission, the Office Action then asserts, without citing any authority, that it is well known in the art for dynamically routing these messages via Internet, providing these messages to include IP addresses in the header. The Office Action also asserts that it is well known in the art to include a connection server for storing IP addresses for Internet telephony communication.

However, these unsupported assertions do not address the claim language. While messages may be dynamically routed, and the IP addresses in the messages may change from hop-to-hop, that does not mean that the assigned protocol addresses are "dynamically assigned upon connecting to an Internet and is temporary for each instance of connecting to the Internet." Rather, a route between two statically issued IP addresses, having many hops therebetween, could change from message to message without the addresses of the intermediate points ever changing dynamically. Additionally, while the change in routing would necessitate changes in addresses in messages to go between the various points, the addresses of the points on the route need not be "temporary for each instance of connecting to the Internet," as recited in Claim 1. In short, it appears that the outstanding Office Action is attempting to take Official Notice that dynamic address assignment is inherent in the usage of packet-based telephony systems, which it is not.

The outstanding Office Action attempts to remedy the admitted deficiency of the '865 patent by relying upon the '736 patent. However, the Office Action fails to provide sufficient motivation as to why one of ordinary skill in the art reading the '865 patent and the '736

[1] Outstanding Office Action, page 3.

patent would have been motivated to include the teachings of the '736 patent and the '865 patent. Rather, the Office Action alleges, without citation to authority, that the '736 patent is "from the similar field of endeavor." However, the '736 patent does not relate to Internet telephony in any form. The '736 patent relates to a method for billing transactions over the Internet. Thus, while the addressing scheme of the '736 patent may be "easily adopted," there is no evidence that one of ordinary skill in the art would have been so motivated, especially as the '736 patent does not relate in any way to internet telephony. In other words, where is the indication in the '865 patent (or anywhere else in the record) that the system of the '865 patent is deficient such that one of ordinary skill in the art would have sought to modify the teachings of the '865 patent?

Additionally, as set forth in MPEP § 2144.03, it is not appropriate to take Official Notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Moreover, it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principle evidence upon which the rejection is based. *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). Accordingly, Applicants again request that the next Office Action provide a citation to support the allegation that "it is also well known in the art to include a connection server for storing IP addresses for Internet telephony communication."

Thus, as the outstanding Office Action has failed to provide a *prima facie* case of obviousness with respect to Claims 1, 12, 23, 31, and 32, it is respectfully requested that the outstanding rejection of these claims be withdrawn.

Moreover, it is respectfully submitted that there is no basis in the teachings of either of these references to support the applied combination. Certainly, the outstanding Office Action fails to cite to any specific teachings within either of the '865 patent or the '736 patent

to support this combination. Accordingly, it is respectfully submitted that the combination of the '865 patent and the '736 patent is the result of hindsight reconstruction, and is improper.

With respect to the outstanding rejection of Claims 2-11, 13-22, and 24-30 under 35 U.S.C. § 103(a), that rejection is also respectfully traversed.

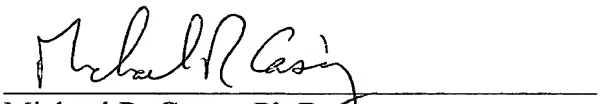
As noted above, independent Claims 1, 12, and 23 all recite dynamically assigned protocol addresses that are dynamically assigned upon connecting to an Internet and is temporary for each instance of connecting to the Internet. As the '422 patent is not relied upon to remedy the deficiencies identified above in the combination of the '865 patent and the '736 patent, it is respectfully submitted that the Office Action has again failed to provide a *prima facie* case of obviousness with respect to Claims 2-11, 13-22, and 24-30. It is therefore respectfully requested that this rejection be withdrawn.

Moreover, it is respectfully submitted that there is no evidence in the record as to why one of ordinary skill in the art reading the '865 patent and the '736 patent would have been motivated to include the teachings of the '422 patent therein. Accordingly, it is respectfully submitted that this combination is based upon hindsight reconstruction and is improper.

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Michael R. Casey, Ph.D.
Attorney of Record
Registration No. 40,294

Katherine D. Pauley
Registration No. 50,607

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

I:\ATTY\KDP\25's\253355US\253355US-AM 4-15-05.DOC